

REMARKS

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Priority Document

The Office Action Summary fails to acknowledge applicants' claim for foreign priority under 35 USC 119 and receipt of the priority document. A certified copy of the priority document JP 2000-10146 was filed in the parent application, Application No. 09/753,569. Acknowledgement of receipt of the certified copy of the priority document is respectfully requested in the next communication from the Examiner. This is applicants' third request for this acknowledgement.

Claim Rejections – 35 USC § 112

Claim 8 has been amended to overcome the outstanding rejection for lack of enablement. It is now recited in claim 8 that an average particle size of the powder is less than 0.1 μm . Support for this amendment is found at page 8, lines 19-23. Therefore, claims 7 and 8 are no longer inconsistent and the rejection for lack of enablement should not be maintained.

Claim Rejections – 35 USC § 102

Applicants traverse the rejection under 35 USC 102 of claims 6, 10 and 11 as being anticipated by JP 08-092484 (JP '484) for the following reasons.

JP '484 is different from the present invention because JP '484 discloses a method wherein, the powder is first coated with a silicone compound having at least one Si-H group and, then, the silicone compound-coated powder is further reacted with olefin compounds (e. g., $\text{R}^{11}\text{R}^{12}\text{C} = \text{CR}^{13}\text{R}^{14*1}$) capable of reacting with the Si-H group, at 300°C or less, preferably 0 - 250°C, as mentioned in paragraph number [0046] of the English translation of JP '484. Examples of olefin compounds include 2-hydroxy-3-allyl-4-methoxybenzophenone, allyl-3,4,5-trimethoxy cinnamate, 4-allyloxy-4'-t-butylbenzoyl methame, tetradecene, glycerol- α -monoallyl ether, chloromethyl styrene, perfluoro octenes (IIa), allylglycidyl ether, and tetraols (IIb).

Thus, the present invention does not involve olefin compounds capable of reacting with the Si-H group derived from the silicone compound. As a result, the present invention relates to compounds having an -SiOH group and -Si-O-Si-O...group. This is not the case in JP '484. When $R^{11}R^{12}C = CR^{13}R^{14}$ was used, the -Si-H group on the coating is changed to -Si-CR¹¹R¹²CHR¹³R¹⁴, for example. Accordingly, JP '484 neither discloses nor teaches the present invention.

Claim Rejections – 35 USC § 103

With respect to the rejection under 35 USC 103 of claims 6, 10 and 11 as being obvious over JP 09-268271 (JP '271) in view of US 2002/014094 (US '094), applicants traverse for the following reasons.

The Examiner is of the opinion that JP '271 teaches a method of coating a nanoparticle or powder with various silicone-based materials. According to JP '271, the powder substance can be coated with a silicone based material at about 400°C. However, according to US '094, the metal-coated powder particles are desirably treated at 200 - 500°C for 30 min to 4 hours. See paragraph number [0101].

First of all, applicants wish to point out that US '094 does not teach coating a surface of the powder with the specified silicone compound (1) of the present claims.

Moreover, according to JP '271, the reaction mixture after contacting the powder material with a mixture of a silicone compound is generally heated at about 70 - 120°C, but the heating at about 400°C is also usable depending upon the particles.

However, as shown in the attached Rule 132 Declaration executed by Mr. Kanemaru, the desired hydrophobicity of the resultant powder can be obtained when the coated powder was heated at 160°C, 260°C, 400°C, 500°C, but not at 600°C. See Table of the Rule 132 Declaration. The heating times are all 1 hour, furthermore, the undesirable generation of hydrogen (see page 2, lines 7 - 22 of the specification) occurs when the coated powder is heated at 160°C, but does not substantially occur at 260°C - 600°C, especially at 400°C - 600°C. This is also clear from the Figure attached to the Rule 132 Declaration, where Si-H peaks are found in IR chart in the case of the heating at 160°C and also in the non-heating case.

Since the description in paragraph number [0039] of JP '271 suggests that even when the powder is heated at 400°C, similar results can be obtained when the powder is heated at 70 - 120°C. However, the results after heating at 400°C is remarkably different from the heating at 160°C as shown in the enclosed Rule 132 Declaration. JP '271 suggests the results are the same or similar when the powder is heated at 400°C. Therefore, JP '271 by no means teaches or suggests the heating temperatures of the present invention.

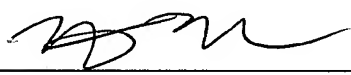
Conclusion

The Commissioner is hereby authorized to charge any additional fees that may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741.

Respectfully submitted,

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